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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,507	02/13/2002	Marco Peters	Q68452	7621

7590 07/27/2004
Sughrue Mion Zinn
Macpeak & Seas
2100 Pennsylvania Avenue NW
Washington, DC 20037-3213

EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

[Handwritten mark]

Office Action Summary	Application No. 10/049,507	Applicant(s) PETERS ET AL.	
	Examiner William C. Vaughn, Jr.	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/02</u> . | 6) <input type="checkbox"/> Other: _____ |

wa

DETAILED ACTION

1. This Action is in regards to the most recent papers received on 13 February 2002.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement submitted on 13 February 2002, have been considered by the examiner (see attached PTO-1449).

Drawings

3. It is requested that Applicant include with each reference number a reference label identifying the specific reference number (i.e., Reference number 2, terminal) in figure 1.

Claim Objections

4. Claims 1-10 are objected to because of the following informalities: the term “characterized” is suggested to be changed to --characterized--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-3, 5 and 7-10** are rejected under 35 U.S.C. 102(b) as being anticipated by Gupta et al., (Gupta), WO 99/60459.

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7. Regarding **claim 1**, Gupta discloses *telecommunication system for receiving at least one control signal from a user via a terminal* (Gupta teaches a client utilizing a browser provides to a DNS resolver a web server name [see Gupta, abstract, see page 6, lines 15-17, page 13, lines 3-17] *and comprising said terminal and a network for in response to said at least one control signal addressing a memory comprising information to be supplied to said terminal and stored at least one memory location defined by at least one address signal* (Gupta teaches that the DNS server responds, when appropriate, with data, a table of data, or a thin client applet to the client browser), [see Gupta, page 13, lines 13-27 and page 14, lines 1-19]; characterised in that said telecommunication system comprises a generator (DNS server) for generating at least one address signal in response to said at least one control signal in a user-dependent way (Gupta teaches that primary DNS server handles requests from other resolvers such as request 207 as well as request from a client browser resolver), [see Gupta, Page 14, page 4-25 and page 15, lines 1-15]. By this rationale **claim 1** is rejected.

8. Regarding **claim 2**, Gupta discloses *characterised in that said user-dependent way comprises at least one location dependency and/or at least one time-dependency* (Gupta teaches utilizing distance metric tables that are created by agents collecting network topology and load information), [see Gupta, page 16, lines 5-17 and Col. 17, lines 1-12]. By this rationale **claim 2** is rejected.

9. Regarding **claim 3**, Gupta discloses *characterised in that at least one part of said generator is located in said network* (Gupta teaches a local area network and the internet), [see Gupta, items 125 and 122]. By this rationale **claim 3** is rejected.

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10. Regarding **claim 5**, Gupta discloses *characterised in that at least one part of said generator is located in said terminal* [see rejection of claim 1, supra]. By this rationale **claim 5** is rejected.

11. Regarding **claim 7**, Gupta discloses *a network* [see Gupta, items 122 and 125] *for use in a telecommunication system for receiving at least one control signal from a user via a terminal and comprising said terminal and said network for in response to said at least one control signal addressing a memory comprising information to be supplied to said terminal and stored at least one memory location defined by at least one address signal, characterised in that said network comprises a generator for generating at least one address signal in response to said at least one control signal in a user-dependent way* [see rejection of claim 1, supra]. By this rationale **claim 7** is rejected.

12. Regarding **claim 8**, Gupta discloses *a terminal* (Gupta teaches a client browser) *for use in a telecommunication system for receiving at least one control signal from a user via said terminal and comprising said terminal and a network for in response to said at least one control signal addressing a memory comprising information to be supplied to said terminal and stored at least one memory location defined by at least one address signal, characterised in that said terminal comprises a generator for generating at least one address signal in response to said at least one control signal in a user-dependent way* [see rejection of claim 1, supra]. By this rationale **claim 8** is rejected.

13. Regarding **claim 9**, Gupta discloses *a generator* (DNS server) *for use in a telecommunication system for receiving at least one control signal from a user via a terminal and comprising said terminal and a network for in response to said at least one control signal*

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addressing a memory comprising information to be supplied to said terminal and stored at least one memory location defined by at least one address signal, characterised in that said telecommunication system comprises said generator for generating at least one address signal in response to said at least one control signal in a user-dependent way [see rejection of claim 1, supra]. By this rationale **claim 9** is rejected.

14. **Claim 10** list all the same elements of claims 1, 7-9, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claims 1, 7-9 applies equally as well to claim 10.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Ebrahim, EP 0 817 444 A2.

17. Regarding **claim 4**, Gupta discloses the invention substantially as claimed. However, Gupta does not explicitly disclose characterised in that said at least one part of said generator performs said generating in dependence of a location signal to be generated via said network.

18. In the same field of endeavor, Ebrahim discloses (e.g., system for context-dependent name resolution). Ebrahim discloses *characterised in that said at least one part of said*

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generator performs said generating in dependence of a location signal to be generated via said network [see Ebrahim, Col. 4, lines 10-59, Col. 5, line 1-59 and Col. 6, lines 1-57].

19. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Ebrahim's teachings of a system for context-dependent name resolution with the teachings of Gupta, for the purpose of decreasing congestion [see Ebrahim, Col. 1, lines 50-59]. By this rationale **claim 4** is rejected.

20. Regarding **claim 6**, Gupta-Ebrahim discloses *characterised in that said at least one part of said generator performs said generating in dependence of a further location signal to be generated via said terminal* [see Ebrahim, Col. 3, lines 1-14]. The same motivation that was utilized in the combination of claim 4 applies equally as well to claim 6. By this rationale **claim 6** is rejected.

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-10 of copending Application No. 09/974,836. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

Conclusion

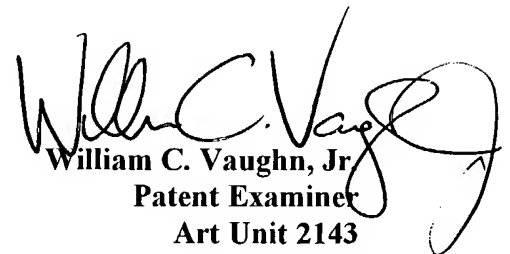
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William C. Vaughn, Jr.
Patent Examiner
Art Unit 2143
20 July 2004